

No. 6862

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit 14

KILLEFER MANUFACTURING COMPANY

(a corporation),

Appellant,

VS.

DINUBA ASSOCIATES, LTD. (a corporation),

Appellee.

BRIEF FOR APPELLEE.

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DINUBA ASSOCIATES, LTD. (a corporation),

Appellee.

BRIEF FOR APPELLEE.

STATEMENT.

Appellee, plaintiff in the Court below, brought suit for infringement of patent No. 1,584,644 for a "Power Lift Implement," granted May 11, 1926, the appellee being the owner of the patent, having acquired the same through a chain of assignments from the patentee, Hugo Petzoldt.

THE PETZOLDT PATENT.

The patent sued on appears as Plaintiff's Exhibit 1. It covers an implement having a power lifting device thereon for lifting the working device on the implement into an elevated position from one of

contact with the ground on which the implement rests. The Petzoldt patent calls for a frame 1, on which a crank axle 4 is journaled transversely, there being a ground wheel 5 rotably mounted on a spindle 6 formed on each of the opposite ends of the axle 4. Each traction wheel 5 is provided with a pair of spaced discs 11 and 12 thereon, around each spindle, and the respective discs are connected by a plurality of pins or rollers 23. The discs and rollers are defined as a ratchet, generally indicated by the numeral 10. An elongated pawl 15 is pivotally mounted on each of the opposite sides of the frame 1 at a point underneath the axis of the axle 4, and said pawls normally extend forwardly alongside of the axle arms. Each pawl has a hooked end 15^a which terminates above the pins 23 of the ratchet 10. The hooked end of the pawl is moved into contact with the ratchet by means of a manually actuated lever 25, whereby the hooked end of the pawl will engage with one of the rollers of the ratchet and as the discs rotate with the wheels, the next succeeding or following roller will disengage the hooked end of the pawl from the ratchet. The forward rotational movement of the wheels 5 is thus used, through the ratchet and pawl assembly, to raise the frame of the implement relative to the ground.

The Petzoldt patent contemplates that heavy, earth working tools, such as sub-soil plows, cultivators, road levelers, etc., would be secured to the under side of the frame, the object of the invention being to lift the earth working tool out of the ground by a par-

ticular form of power lifting device. It is this power lift device which is the subject matter of the claims of the patent in suit.

AT THE START OF THE TRIAL IN THE DISTRICT COURT, THE ATTORNEY FOR APPELLEE STATED THAT THE PETZOLDT PATENT IN SUIT WAS TO BE STRICTLY LIMITED TO THE CLAIMS THEREOF; THAT THE PLAINTIFF DID NOT SEEK A BROAD INTERPRETATION OF THE CLAIM; THAT THE CLAIM SHOULD BE STRICTLY CONSTRUED; AND THAT CLAIM 1 WAS NOT ENTITLED TO A FULL RANGE OF MECHANICAL EQUIVALENTS. (R. 54.)

Judge St. Sure, in his opinion, recognized the limited scope of the claim of the patent in suit as evidenced by the following excerpt (R. 41):

“The patent is for a power lift device for heavy earth working tools such as sub-soil plows, cultivators, road levelers, and road building machinery. Such devices are old in the art and all of the elements are ancient. The claims are therefore narrow.

Petzoldt conceived the idea of a combination for a power lift device which operated with an automatic kick-off. This feature is simple and novel, and, as the file-wrapper shows, was the inducing cause for the issuance of the patent.”

THE PATENT CLAIM INFRINGED BY APPELLANT.

Claim 1, of the patent in suit, reads as follows:

“In a power lift implement, a frame, an axle journaled transversely of said frame, an arm on each end of the axle, each arm terminating at the lower end with a spindle, traction wheels rotatable on said spindle, a pair of spaced discs mounted on one spindle and fixed to the adjacent wheel, a plurality of pins extending transversely between the discs, and at regular intervals in a circular formation adjacent the edges of the discs, an elongated pawl pivotally mounted on the frame at a point underneath the axis of the axle and normally extending forwardly alongside of the adjacent arm, said pawl having a hooked end terminating above the pins, means for swinging the pawl into an engageable position with said pins, *whereby when the hooked end is engaged with one pin and the discs rotate, the next succeeding pin will engage the pawl to disengage the hooked end.*” (Italics ours.)

Appellant has unnecessarily exerted itself to show that the description of the kick off mechanism contained in the italicized last four lines of this claim was the inducing cause for the issuance of this patent. Obviously it was. But the appellant further contends that the description of this mechanism so far modifies the preceding and unitalicized portion of the claim as to form a structure which is not to be found in the infringing device manufactured by appellant—and with this contention we join issue.

THEORY OF INFRINGEMENT.

Appellee filed this suit for infringement against the appellant, on the theory that the machines manufactured by the appellant contained every element of the claim of the Petzoldt patent owned by appellee, and that perforce the appellant's machines infringed.

The appellee urged, introduced testimony to show, and physically demonstrated, apparently to the satisfaction of the Court below, that certain machines manufactured by the appellant were identical in substance with the subject matter of the claim of the patent in suit, and that said machines would accomplish the same purpose by substantially the same means, operating in substantially the same way.

The appellee contended, introduced evidence to prove, and physically demonstrated that these certain machines manufactured by the appellant did embody the structure and follow the mode of operation recited by the last four lines of the claim in suit. The Court below found that the particular "kick-off" mechanism which was the "inducing" cause for the issuance of the patent to the appellee's patentee actually was a part of the appellant's structures.

The appellant contends that the machines which it manufactures, follow the teachings of a patent issued to one Arthur W. Hudson on April 23, 1929, appellant being the owner of said patent. Appellant admits that its machines contain all of the elements of the Petzoldt patent in suit, except that described by the following language of claim 1,

"* * * whereby when the hooked end is engaged with one pin and the discs rotate, the next suc-

ceeding pin will engage the pawl to disengage the hooked end.” (R. 42.)

Appellant contends that the machines of its manufacture do not infringe upon the claim of the Petzoldt patent because the appellant’s machines are made in accordance with the teachings of the Hudson patent, and that the Hudson patent uses a “kick-off” plate for disengaging the pawl from the pins or rollers on the traction wheels.

Appellant contends that its machines do not rely upon the next succeeding pin to disengage the hooked end of the pawl from the preceding pin, when the implement has been elevated a selected distance out of the soil.

The alleged non-infringing structure used by the appellant is best described by the testimony of defendant’s expert, Mr. William A. Doble, Jr. (R. 43):

“Q. Now, in that structure as disclosed by the Hudson patent, Defendant’s Exhibit ‘B-4,’ how are the pawls as disclosed in this patent disengaged from the ratchet wheels which are secured to the ground wheels of the implement?”

A. In the Hudson patent, Defendant’s Exhibit ‘B-4,’ the pawls are disengaged from the ratchet wheels by means of a stop mounted upon the actuating lever. The stop or kick-off plate is No. 60, and is most clearly seen in Fig. 4. As the implement reaches the predetermined point at which the pawl is to disengage from the ratchet wheel, the kick-off plate 60 engages the crank axle 5, holding the pawl from further movement, and thereby disengaging the pawl from the ratchet wheel.”

While the expert for the appellant-defendant, stated in his testimony that the machines manufactured by the appellant-defendant do follow the teachings of the Hudson patent and do not follow the teachings of the Petzoldt patent in suit, we find the following very enlightening admission made by this expert, William A. Doble, Jr. (R. 43.)

“The Court. Would this Hudson machine operate without the kick-off plate?

“A. *Yes, your Honor.* It largely depends on the construction of the machine. In the construction of agricultural tools the manufacture is rather crude, and the adjustment plate is an important feature, because then the exact point of release can be accurately adjusted.” (Italics ours.)

FIELD DEMONSTRATION BY APPELLEE.

Immediately previous to the conclusion of the trial of the cause in the lower Court, the Court and counsel proceeded to witness a field demonstration of a machine of appellant's manufacture, which demonstration was conducted by the appellee. (R. 201-202.)

The Killefer tool which the appellee demonstrated was a machine which had been manufactured and sold by the appellant-defendant. Raymond Gallagher, an individual connected with the company owning the Killefer machine in question, which is shown in the photographs marked as Plaintiff's Exhibits 7, 8, 9, 10, 11 and 12, testified that the particular machine in question had been purchased by his company on or about June the 5th, 1929, as a No. 10 Killefer

Scarifier, from the West Coast Tractor Company. (R. 173.)

Witness further testified that the serial number of the machine was 10,112, which number he had copied from one of the bills connected with the purchase of the machine in question. During the trial, when the photographs of the machine in question were offered as exhibits, Mr. Lewis E. Lyon, attorney for the appellant, made the following admission (R. 78):

“The Court. Perhaps it might save time if you admitted that it was a Killefer tool.

Mr. Lyon. *That is a Killefer tool, it has a mark on it, but when it was manufactured, or how it was constructed is another matter.* (Italics ours.)

The Court. Let us save all the time we can.

Mr. Lyon. I am perfectly willing to if I have an opportunity to inspect it.

The Court. One of the members of your firm could tell by looking at it when it was made.

Mr. Johnson. There is no doubt it was a Killefer tool, is there?”

To this, no answer was returned.

The Killefer tool shown in these photographs, Plaintiff's Exhibits 7, 8, 9, 10, 11 and 12, was without a kick-off plate or other type of camouflage mechanism for disengaging the pawl from the rollers. This same machine, about which the witness Gallagher testified, had never been in the possession of or under the control of the appellee, but appellee knowing that such a tool was located in the City and County of San Francisco, arranged to have it demonstrated to the

Court to substantiate appellee's theory of infringement.

The demonstration performed by the appellee consisted of hooking a large "Caterpillar" tractor to the draw bar of the infringing scarifier, and then pulling said scarifier about a field. The driver of the tractor operated the infringing instrument in the manner in which the implement was intended to be operated, to wit, the scarifying tool was allowed to drop so as to enter into the earth. Thereafter the pawls on the implement were engaged with rollers on the wheels of the infringing implement, and the scarifying tool was elevated out of the ground by means of the power lifting apparatus which is the subject of this controversy, *and the pawls were automatically disengaged from the rollers on the wheels by the rollers following the ones engaged by the pawls.* As the Killefer implement was being demonstrated, the Court, the attorneys, and the experts walked alongside thereof,—the rate of speed of the tractor and infringing scarifier being such that the operation of the power lift when lifting the plowing tool up out of the earth could be carefully watched. The power lift for raising the plowing tool from the earth, was operated many times during this demonstration. On every occasion the hooked end of the pawl which was engaged with the pin or roller, was disengaged therefrom by the next succeeding pin, after the plowing tool had been raised to a selected clearance above the ground. The Court very carefully observed that there was no kick-off plate on this particular Killefer implement, nor was there a kick-out device on said machine which would

disengage the pawls from the rollers on the wheels in the manner of operation described by appellant's expert witness, William A. Doble, Jr.

Upon returning to the Court after this demonstration, the following colloquy ensued (R. 202):

“The Court. Are you ready, Mr. Johnson, to proceed?”

Mr. Johnson. Yes.

Mr. Lyon. Your Honor, with reference to the tool which was just demonstrated, the defendant desires to have it understood that they do not admit that tool is in the present condition of its manufacture, and if your Honor desires, I have several witnesses that I can put on relative to that matter.”

Undoubtedly the demonstration performed by the appellee proved to the satisfaction of the Court that the machine manufactured by the appellant contained each and all of the elements of the claim of the Petzoldt patent in suit; that it performed its operation in the same manner as that specified in the “inducing” clause of the claim of the patent in suit; and substantiated appellee's theory of the case that appellant was manufacturing a machine which was an infringement upon the claim of appellee's patent.

This test of infringement seemed to be conclusive, otherwise the attorney for appellant would not have set up the cry that the Killefer tool had been tampered with, or that the machine was not in the same condition of manufacture as that in which it had been when it left the Killefer factory. Appellant's attorney raised this same cry in the field during the demon-

stration by appellee, and the Court had ample opportunity to examine the machine and to determine if the machine had been mutilated or changed from its original form.

Appellant's attorney stated he could produce witnesses (R. 202) to testify that the machine which had been demonstrated was not in its original condition of manufacture. The appellant was free to offer these witnesses in surrebuttal, but they were never brought in. It was not the Court's province to advise the appellant whether or not the witnesses should be put on the witness stand. The offers of proof by appellant were strictly up to the appellant and not to the Court.

The position in which the appellant found itself, after witnessing a machine of its own manufacture operating in a manner constituting an infringement of the claim of the patent in suit, is explained by the following statement appearing in Appellant's Brief, page 22:

“In inducing the District Court to believe that the Killefer implement might operate in the manner requisite to the Petzoldt patent, and which was the inducing cause for the issuance of this patent, *plaintiff demonstrated to the District Court an implement which was not a Killefer implement. The machine demonstrated by plaintiff had been reconstructed and the parts had been entirely reassembled. It was not as manufactured and sent out by the Killefer Company. An offer was made by defendant to the District Court to prove this fact, which offer was refused.*” (Italics ours.)

Tearing this last quotation to pieces, we find appellant taking the position that the machine which the appellee, plaintiff, demonstrated, was not a Killefer implement. This bald denial is made in view of the previous explicit admissions by appellant quoted above. (R. 78, 202.) What effrontery for the appellant to admit the tool which appellee demonstrated to be a tool of its manufacture, and then to flatly deny the origin of the machine in its Brief.

In the next breath, the appellant states unequivocally, "That the machine demonstrated by appellant had been reconstructed and the parts had been entirely reassembled." This statement is diametrically opposed to the truth. There is not one iota of evidence anywhere in the record to show that the machine which the appellee demonstrated was other than in its original condition of manufacture. The appellant was not denied the right to offer proof to show that the machine in question had been reconstructed or reassembled. The appellant neglected and failed to offer any evidence to substantiate its theory that the Killefer tool which had been demonstrated by appellee, had been mutilated or reconstructed, unless the conclusion expressed by Mr. Doble (R. 203) that the machine could not have worked as it did without having been "mutilated", deserves the name of evidence. Because of this failure of appellant to offer proof, the cry is raised that the appellee "framed" the demonstration with the machine of appellant's manufacture.

Further on in this same quotation from Appellant's Brief it is stated:

“It (the machine), was not as manufactured and sent out by the Killefer Company.”

Appellant admits in one breath the machine in question is a Killefer machine and in the next breath it is denied. Knowing that the Court would believe the machine in question to be a machine of the Killefer manufacture, the appellant then attempts to wiggle out of the precarious position in which it was placed, by stating that the machine in question was “not as manufactured by the Killefer Company.” Yet where in the Record is there any evidence to show that the machine in question was not in the same condition as that in which it left the Killefer plant?

Finally, the appellant states that

“It offered to prove to the District Court the fact that the machine in question was not as manufactured by the Killefer Company, which offer the Court refused.”

The District Court did not refuse the appellant anything, much less any offer which the appellant claims to have made. The following excerpt from the Record speaks for itself as to whether or not the appellant made any offer such as it alleges was made in its Brief.

“Mr. Lyon. Your Honor, with reference to the tool which was just demonstrated, the defendant desires to have it understood that they do not admit that tool is in the present condition of its manufacture, and *if your Honor desires*, I have several witnesses that I can put on relative to that matter.

The Court. Have you got a new tool here?

Mr. Lyon. Yes, we have a new tool here. I have a new tool in the Killefer storeroom down there which has been inspected by the plaintiff here. We have allowed them to inspect it several times.

Mr. Johnson. Of course I could interpose other testimony by other users of these same implements that they will work precisely like the one your Honor saw, and I think we could go on, here to the end of doom, showing they work both ways." (R. 202.)

It admits of no argument that the manufacturer of a machine could not be charged with infringement of a patent where the machine had been converted into an infringing article after it left the possession of the manufacturer. The appellee is not attempting to rest its case upon such a weak premise. There has been no evidence introduced and made of record in this case tending to prove that the Killefer machine which had been demonstrated, had been misused or reconstructed.

That the structures manufactured by the appellant, Killefer Manufacturing Company, contain all of the elements of the claim of the Petzoldt patent in suit, is clearly established by plaintiff's expert, Mr. Baldwin Vale.

"My opinion with respect to the placement of the axle on the Killefer structure with reference to the corresponding placement of the axle as shown in the Petzoldt patent is that they are the same and both are pivoted above the frame. My opinion is that there is no dissimilarity between the pins that were mounted on the discs and the

respective traction wheels of the Killefer device and the Petzoldt patent, and that they are alike for the purpose of mechanics. I would describe the pins of the disc in the Killefer device as being a ratchet wheel in the common, ordinary term of a ratchet wheel, and it has a ratchet and pawl construction regardless of their particular individual characteristics. I would say that in my opinion there is no difference in the mode of operation of the device as it is constructed with reference to the Killefer Company." (R. 82.)

APPELLANT'S THEORY OF NON-INFRINGEMENT.

The question of whether or not the machines manufactured by the Killefer Company infringe upon the claim of the Petzoldt patent, depends upon whether or not the kick-off plate is indispensable to the operation of the appellant's machine. The theory of the Killefer Company is that their structures do not infringe because they manufacture machines which are supposed to include a definite element, known as a "kick-off" plate, which is supposed to disengage the pawl from the pins on the traction wheels. The Petzoldt patent specifies that one of the rollers following the one engaged by the hooked pawl will automatically disengage said pawl. The appellant confuses the issues, by laying great stress on the fact that the machines of its manufacture had either four or five pins or rollers arranged in spaced relation on the ratchet wheels of its device. It is the appellant's theory that a ratchet wheel having but four circumferentially spaced pins therein, could

not possibly operate in the manner called for in the claim of the Petzoldt patent and that therefore there could be no infringement. The expert witness for the appellee, Baldwin Vale stated that it did not make any difference whether the ratchet wheels had four, five, six, or seven pins therein.

“Mr. Lyon. Q. Will you please examine these photographs which have been shown to you and tell me whether you can tell from these photographs actually whether there are four, or five, six, or seven pins in that ratchet wheel?”

The Court. I think he has already answered that.

A. There is——

The Court. You needn't answer that. It seems to me you have gone into that fully enough. Don't you think so, Mr. Lyon?

Mr. Lyon. I don't know whether he has answered whether it showed five, six, or seven. I think his last answer was a qualification that he could not tell.

A. *I will answer that it does not make any particular difference.*” (R. 98-99.)

The truth of this statement by the witness is kindly confirmed by the appellant itself which lays equal stress upon the alleged fact that its device follows the teaching of the Hudson patent No. 1,710,222 (Defendant's Exhibit B-4). In that patent, may it be noted, the ratchet wheel which the pawl engages, has *six* pins or rollers—not four.

Appellee's expert Vale testified (R. 85) that the whole idea of the Petzoldt patent was to get the succeeding pin to kick the pawl out, and according to said

expert, it was immaterial whether or not there were four, five, six or seven pins in the ratchet wheel.

PROOF OF INFRINGEMENT.

The expert witness, Vale, examined the Killefer machine which was demonstrated to the Court and which was shown on the photographs, "Plaintiff's Exhibits 7 through 12," inclusive, and the infringing manner in which the Killefer tools operated was described by the witness as follows:

"I have examined the structure of the lift in the device that is manufactured and sold by the defendant, Killefer Manufacturing Company, and am thoroughly familiar with the mode of operation of the lifting device as employed in the various Killefer implements. I have also examined a structure like that shown in the photograph heretofore exhibited to me. The traction wheels of the vehicle as shown by the photograph has six pins on each hub which are engaged by the lifting pawls. I saw one of the Killefer implements yesterday that had four pins on the hub. The pins I am referring to are marked on Plaintiff's Exhibit 7 by the word 'pins'; they are the pins between the two discs of the ratchet; I have examined the hooked arms that engage these pins on a number of Killefer implements, and particularly the one shown in these photographs. The mode of operation of the hooked ends of the pins, and what is accomplished thereby relative to the rest of the implement is that when the pawl is dropped the hooked end of the pawl engages the nearest pin as the wheel rotates, and as the wheel continues to

rotate, it pulls on this hooked end of the pawl and hoists the frame of the implement, at which time the succeeding pin engages under the hook and drops it out of engagement with the one preceding it. *I did not notice in the particular structure that is shown in these photographs any means other than the rollers for disengaging the pawl from the wheels.*" (R. 79.) (Italics ours.)

Appellee does not predicate its case of infringement upon the assumption that the Killefer tool may be mutilated or reconstructed in such a way that the Killefer tools will operate so that the following roller causes the hooked pawl to be kicked off. Appellee predicates its charge of infringement upon the fact that Killefer made and sold tools which do operate in precisely the same manner as that set forth by claim 1 of the patent in suit, without the necessity of mutilating or reconstructing the tools. There is ample proof in the Record of this case, that the Killefer machines, however various, include a power lift which will operate to be disengaged by one of the following rollers on the ratchet wheel, and not through the instrumentality of any kick-off plate.

There is uncontradicted proof that the Killefer Company made and sold at least one particular tool, which was demonstrated to the Court, "Plaintiff's Exhibits 7 through 12," inclusive, and which was so constructed originally as to include a power lift mechanism in which the hooks or pawls of the lift are disengaged by the next succeeding pin of the ratchet wheel.

INFRINGEMENT BY APPELLANT NOT CAMOUFLAGED BY
KICK-OFF PLATE.

The appellee introduced both as a fact and as an expert witness in farm implements, Casper Zwierlein, Jr. Zwierlein is a graduate of the College of Agriculture of the University of California, and majored in farm machinery. Since his graduation from the University of California, he has been continuously engaged in the business of selling earth working tools, having for many years been connected with the John Deere Plow Company, and between the years 1921 and 1929 inclusive, was a distributor for the Killefer Manufacturing Company's line of implements, in the San Joaquin valley. The qualifications of Zwierlein as an expert in farm machinery were not denied. (R. 58.) Zwierlein was thoroughly familiar with the construction of the entire line of Killefer tools and it was not denied that he had been one of the most successful distributors of Killefer tools in the State of California.

Bearing upon the question of the type of power lifts which were used by the Killefer Company and which were embodied in the tools of their manufacture during the period of his association with the Killefer Company, Zwierlein testified as follows:

“The Killefer tools were equipped with this type of power lift when I commenced selling their merchandise in 1921. In this structure the chain had caused so much trouble in either breaking, stretching or getting caught around it that the chain was eliminated and then an arm was made a part of the fork casting. This change was made, I should say, about 1923, and at that time

the arm was made as a solid part of the fork to accomplish the same purpose in kicking the fork away from the ratchet.

The Killefer Manufacturing Company had the same form of lift *until the spring of 1924*. An entirely different arrangement was then adopted which consisted of hooks permanently fastened to a round shaft that was attached underneath the frame and ran crosswise, and that part was mounted in bearings so that it could oscillate, and there was an arm attached to that bar and a rope fastened to that that went to the tractor driver's seat, and when this rope was pulled the hooks were moved forward and hooked into or over a pin that was fastened to the wheel, and this particular lifting requires no grousers on the wheels so that the grousers were eliminated from the wheels, and when the rope was pulled, *the hooks would engage the pin lifting the frame out of the ground, and when the frame was sufficiently raised, the next succeeding roller in this disc would come up and kick the hook up and cause the hook to disengage from the pin.* (R. 60.) (Italics ours.)

The testimony of Zwierlein recounts with great particularity all of the changes in construction which the Killefer Company made in the power lifts which were incorporated in its tools. (R. 62.)

Zwierlein was shown the photographs of the Killefer implements, which comprise Plaintiff's Exhibits 7 through 12 inclusive, and his testimony which follows is very pertinent with respect thereto.

"In the 1924 structure a roller following the one engaged by the hook acted to disengage the

hook from the wheel when the frame was lifted, and that was not true of the structure made by the Killefer Manufacturing Company prior to 1924. The photograph handed me I would not say was on all working detail with the various sizes and depths of tools that the Killefer Manufacturing Company sold between the years of 1921 and 1929, but the design was exactly the same as used on all of them, but this photograph shows substantially the way the Killefer tools were built after the year 1924. The wheel axle in these structures is located above the frame. The axle or shaft which supports the hooked arm is located below the frame. This machine is provided with pins or rollers to engage the hooks. In this structure the next succeeding roller kicks the hook off from engagement with the wheel. I do not find any other means on this apparatus or vehicle that would serve the purpose of disengaging the hooked arms from the pins or rollers on the wheels. I have examined the particular lifting operation of this machine, or one exactly like it, on numerous occasions." (R. 63.)

It will be noted that the tools of Killefer manufacture described by Zwierlein in his testimony, are precisely the same type of tool as that set forth in the claim of the Petzoldt patent in suit. Zwierlein further testified (R. 65):

"I sold farm implements of the character I have just described for the Killefer Manufacturing Company from 1924 until 1929."

The testimony of Zwierlein with respect to the so-called kick-off plate alleged to have been used by the

Killefer Company for disengaging the pawls from the ratchet wheels, is as follows:

“The type of kick-off that the Killefer Manufacturing Company had on the tools during the time I was selling them was the angle bracket on the arm welded to the hook. If the kick-off plates that I have described were out of adjustment on the Killefer tools, nothing would happen at the time the wheel was tending to raise the vehicle out of the ground. *The next succeeding roller would kick out the hook arm.* The equipment brought out by Killefer Manufacturing Company in 1924 had *six* pins or rollers around the traction wheels to be engaged by the arms. The same number of pins were used throughout the remaining years up to 1929. I had seen the particular type of lifting device brought out by Killefer Manufacturing Company in 1924, because I saw practically every tool I sold. I had seen tools manufactured by others than the Killefer Manufacturing Company embodying substantially the same structure that was incorporated in the tools brought out by Killefer Manufacturing Company in 1924. The first occasion I had to see one of these tools was one of my best customers, a rancher of about 4,000 acres. I had attempted to sell them a Killefer subsoiler, having sold them a great many thousands of dollars' worth of implements previously. That was my first occasion of seeing a lift, other than Killefer used, which is the type of lift shown on this picture. This structure was exactly the same as shown in this picture here. The manufacturer, or designer, was the Dinuba Agricultural Works. They were located in Dinuba, California. To my

knowledge this business was owned by Hugo Petzoldt." (Italics ours.) (R. 67.)

The Petzoldt patent in suit was filed in the United States Patent Office on March 6th, 1923. At this time Petzoldt was connected with an organization manufacturing farm implements in Dinuba, California. It is inferrable from Zwierlein's testimony that Petzoldt built an earth working implement, including the power lift apparatus, concurrently, or nearly so, with the filing of the patent application on March 6, 1923. The testimony of Zwierlein refers to the improved type of power lift which the Killefer Company incorporated in its tools for the first time in the year 1924. Zwierlein attended a meeting of the officials of the Killefer Manufacturing Company in January of 1924, at which time the form of the power lift device then to be brought out was discussed. (R. 68.) At this meeting there was present Robert Killefer, A. W. Hudson and Robert Whyman, all officials of the Killefer Company (R. 68-69), and Zwierlein testified that he made the following statement at said meeting,

"At this meeting I brought up the point of the lifting device and I said to Mr. Killefer, in the presence of the other gentlemen mentioned, that the power lift employed on the Killefer tools was giving so much trouble, requiring so many trips that were expensive to adjust them, and keeping the customers satisfied, that in view of the fact that a better power lift had been adapted by a company, one that the customers acknowledged was better, I said that I thought it would be a

mighty good plan to adopt something that would be equally efficient, otherwise we could not hope to retain the volume of business that we had done for the Killefer Manufacturing Company, because the competitors would naturally have the advantage of us.”

Which testimony remains uncontradicted.

Following this meeting the Killefer Company came out with its improved power lift, and the circumstances attending the adoption of it were stated by Zwierlein as follows:

“In the spring of 1924, Mr. Robert Whyman telephoned me that he was coming to Stockton, and wanted me to be sure to meet him. He said that Mr. Hudson was to meet him there at my place of business. Mr. Hudson was coming from the factory at Huntington Park. Mr. Hudson appeared, and the major reason for his visit was the adoption of the power lift to take the place of the old one. Mr. Hudson told me that he had just come from Dinuba, and also from around Fresno, where Budd & Quinn—Mr. Hudson was at that time general manager of the Killefer Company—that Budd & Quinn, Killefer distributors for Fresno county, knew where various Dinuba tools were located, and had taken Mr. Hudson out to see them. Mr. Hudson told me then he was just coming from there, where he had investigated these lifts on the Dinuba implements, and had interviewed people that had used them and found them to be very satisfactory, *and he told me that it was his intention to adopt that lift on Killefer implements.* Mr. Whyman, who was also present, called attention to the fact that there was a pat-

ent covering that lift. Mr. Whyman was sales manager of the Killefer Manufacturing Company. Mr. Hudson said that he knew that there was a patent, because he had read over the patent, that Mr. Petzoldt, who was—I don't know whether he was proprietor or general manager of the Dinuba works, but anyway Mr. Petzoldt seemed to be the head man of the Dinuba works—he said that Mr. Petzoldt, or the Dinuba Agricultural Works, had been broke, had been refinanced, and they were about broke again, and he did not anticipate any trouble from that source, that they were just about on their last legs, and going out of business, and he was going to adopt that lift just as it was. I said he might be wishing trouble onto himself, and then Mr. Whyman said, 'Don't you think you had better offer Petzoldt a job at the factory, because he was a designer, and you can get him to grant you a permit to use it?' And Mr. Hudson said, 'I do not want him around, he is an erratic sort of fellow, and I do not anticipate we will have any trouble, at all.'” (Italics ours.) (R. 69-70.)

The Hudson referred to in the testimony of Zwierlein, is the same A. W. Hudson, the patentee of the Hudson patent No. 1,710,222, which was assigned by Hudson to the Killefer Company. Zwierlein named Mr. Whyman and Mr. Hudson as the individuals who had examined the Petzoldt tools in the spring of 1924, and who stated it was their intention to adopt that lift on Killefer implements. This testimony of Zwierlein as to Whyman and Hudson was not contradicted, explained or modified, nor was there any attempt made to lessen its damaging effect. Both Mr.

Hudson and Mr. Whyman are still living, and if Zwierlein's testimony had been otherwise than truthful, it was within the power of appellant to produce Whyman and Hudson, to contradict Zwierlein's testimony, if they could have done so. But neither of them was produced.

The appellant has attempted to attach some significance to the camouflage "kick-out" plate which was placed upon some of the Killefer implements. Zwierlein discussed this matter with Mr. Whyman and Mr. Abrahams, both of the Killefer Company, and following is Mr. Zwierlein's uncontradicted testimony with respect to what ensued at that conference.

"I inquired why it was necessary to put the kick-off plates on the lift where the lift was so satisfactory without any addition. Mr. Whyman and Mr. Abrahams gave me the same instructions: 'That is only on there for looks, if you want to call it that, and if you want to, take it off or instruct the parties buying the machine to take it off because it is not necessary.' In several cases I took it off, but in most cases I left it up to the customer whether they wanted it on, because on several occasions bolts got loose and either would shift one way or the other, so that the bars would not kick off properly, and the roller was taking care of that, and it was perfectly safe without them. In most cases it was removed.

Mr. Abrahams was a traveling man for the northern part of the state of Killefer Company."
(R. 71.)

The Mr. Abrahams referred to by Mr. Zwierlein in his testimony, was present in San Francisco at the

time of the trial in the lower Court and yet he was not called upon to contradict the testimony of Zwierlein. Surely if Zwierlein had been untruthful, the appellant would have produced Abrahams to refute Zwierlein's testimony.

Appellant's brief is replete throughout with denials that they ever, at any time, manufactured any implements having a power lift thereon which could be remotely considered as the equivalent of the power lift called for by the claim of the Petzoldt patent in suit. The unqualified, undenied testimony of Zwierlein of record, is that during the years 1924 to 1929 inclusive, the Killefer Company did manufacture and sell implements with a power lift thereon which was a "Chinese copy" of the device specified in the claim of the Petzoldt patent. Zwierlein left the employ of the Killefer Company in the year 1929, and the following pertinent testimony of Zwierlein indicates that the Killefer Company also manufactured infringing tools *after* 1929.

"Since 1929 I have examined Killefer tools because, being a competitor of theirs, I naturally make it my business to look over machines, and any time I have occasion to look over a machine, I look around to see if there is anything different or new on it. On the tools I have examined since 1929 practically all of them employ this, either this type of arm coming up to the kick off on this angle iron here, or when the bracket was discontinued, when they welded this arm onto the hook, that is, some of them had this extension on there, and some were without that entirely. *And at a time as recently as the spring of 1931, and specifically on the sales floor of the Killefer dealer*

in Stockton, and of the Killefer dealer in Sacramento, I saw tools just like these, without the kick-off arms on the hooks. I noticed that with one exception all of the structures had six rollers, but one machine, I think, had been cut down to four.” (Italics ours.) (R. 71.)

In the Brief of Appellant (p. 23) it is stated that the elimination of the kick-off plate from the Killefer tool is not conclusive that the device will operate in the manner set forth in the claim of the Petzoldt patent in suit. The appellant argues in its Brief, that, if the actuating arm be broken off from its connection with the hooks or pawls, the mere rewelding of this arm to the connecting means of the hooks or pawls in a different position, in order to change the operation of the tool, does not convert the Killefer machine into an infringing article. Why does the appellant make this statement?

On cross-examination, appellant’s expert, William A. Doble, Jr. testified as follows with respect to whether or not the Killefer tools would operate in a manner to infringe upon the Petzoldt claim:

“There is no question in my mind but what every tool manufactured by the Killefer Company disengages the pawl or hooked arm from the pin by some means located on the vehicle, other than the pins on the wheel for disengaging that pawl. I have never seen it operate in any other way. *It is possible that you could make it disengage by the next succeeding pin, but certain of these parts MIGHT have to be distorted.* It is not possible that if the kick-off plate in various of the Killefer structures was slightly out of place

that that action would result. In fact, all of the implements that I have seen and have removed the plates from, the actuating arm engaged a fixed member on the frame, which was either the transverse angle iron frame member or the crank axle to engage the actuating arm to disengage the pawl from the ratchet wheel. I have never distorted a Killefer implement to make any demonstration which would satisfy me that the hooked arm could be disengaged from the pawl purely by the action of the following pin." (Italics ours.) (R. 168, 169.)

Again appellant's expert testifies in a similar vein:

"I do not *know* that the actuating lever would engage the frame to disengage the hooked arm from the pins on the wheel because these parts have not been changed, they are just the same as in the other frame, where the other form of pawl was used." (R. 190.)

In these two instances we have the testimony of appellant's expert that he never made any test to determine if by distorting or reconstructing the Killefer tool it would operate in a manner to infringe. This expert was careful to disclaim any knowledge bearing upon the point of whether or not the Killefer tool as manufactured, would operate as the plaintiff claimed it would.

And on the other hand, it was demonstrated conclusively to the Court by practical operation, and corroborated by the testimony of Zwierlein, that the Killefer tools would operate in an infringing manner without the necessity of any reconstruction or rearrangement of parts.

It would have been very enlightening for the appellant to have learned what the results in operation would have been, had its machine been distorted or reconstructed, instead of especially manufacturing the elaborate structures, Defendant's Exhibits "C-1" through "C-19." Defendant's expert Doble also testified:

"In other words, I would have to move the operating arm, the arm that disengages the hook from the wheel backward by bending or shifting it. I could do this with a blow-torch and some other tools, bend it back at a very nominal cost and within a very short time. *I could have done this quickly, quicker than it took to build the type of rig as I have shown in Defendant's Exhibits 'C-1' to 'C-19,' inclusive.* It did not occur to me to go to that trouble to perform that experiment. Witness was asked if he could better demonstrate the particular point of disengaging the pins from the hooked arm by making the elaborate machines shown in the photographs 'C-1' and 'C-19,' and witness replied: The structures which I built are not very elaborate. All we had to do was make a rack and put it on. They are not expensive. It was very little more expensive to build these structures than it would have been to bend the lever back a little and they are a little more illustrative of what we were endeavoring to show." (R. 152-153.)

A tool made in accordance with the claim of the Petzoldt patent and the tools made by the Killefer Company have precisely the same mode of operation.

The field demonstration performed by the appellee, and the testimony of the witness Zwierlein, and the admission made by defendant's expert (R. 43), preclude the argument that the Killefer machines had a different mode of operation from the one specified by the claim of the Petzoldt patent. In the Killefer machines, which the appellee alleges infringes, there are to be found substantially the same elements, operating in substantially the same manner, through the same mode of operation, and producing the same result. True, the mode of operation portion of the claim in suit was the "inducing" cause for the allowance of the claim to the patentee; but nevertheless, the devices manufactured by the Killefer Company employ that same mode of operation, and therefore said devices infringe upon the Petzoldt patent.

It is true that Petzoldt made no revolutionary invention. Petzoldt contributed a rather narrow improvement in a well filled art. Appellee has asked in this case for an adjudication of its rights with respect to the specific form of apparatus described in the claim in suit, believing that it has demonstrated unequivocally that the devices manufactured and sold by the Killefer Company, embody precisely the same specific form of device covered by the claim of the patent in suit.

In the case of

Bankers' Utilities Co. v. Pacific Nat. Bank, 18

F. (2d) 16,

this Court has said:

“The underlying principles of law are well understood. It is recognized that merely to assemble old elements does not constitute invention. But, upon the other hand, ‘an aggregation and association of old elements may constitute invention, if it rises above mere mechanical skill and produces utility of a superior virtue to that previously attained.’

Bliss v. Spangler, 217 F. (9th C. C. A.)
394;

The Barbed Wire Patent, 143 U. S. 275,
12 S. Ct. 443, 450, 36 L. Ed. 154.

These requirements, we think, are met by the plaintiffs’ device. The improvement wrought by the combination may be simple, but it is substantial and plainly useful. It is not found in the prior art, or covered by the claims in any of the references. While possibly it does not involve a high degree of inventive genius, it rises above mere mechanical skill, and exhibits a measure of patentable novelty.

Defendants show that a Gillette razor case, upon which they read the claims of the Farrington patent, No. 1,217,291, can, by certain changes or additions, be made to exhibit the essential features of plaintiffs’ cover; but Gillette cases were admittedly in common use, and it remained for counsel, under the exigencies of this litigation, and with plaintiffs’ commercially successful device as a model, to suggest the additions. Anticipation is not made out ‘by the fact that a prior existing device, shown in a prior patent, may be easily changed so as to produce the same result as that of the device of the patent in suit where the prior device was in common use, with-

out it occurring to any one to adopt the change suggested by the patent in suit.' ”

Blake Automotive Equipment Co. v. Cross Mfg. Co. (C. C. A.), 13 F. (2d) 32.

In their position plaintiffs are fortified by the presumptions attending a patent,

Wilson & Willard Mfg. Co. v. Bole (C. C. A.), 227 F. 607;

Heinz Co. v. Cohn (C. C. A.), 207 F. 547;

San Francisco C. Co. v. Beyrle (C. C. A.), 195 F. 516,

and by the fact that their device is a commercial success and has brought on imitation.

Application of McClaire (D. C.), 16 F. (2d) 351;

Sandusky v. Brooklyn Box Toe Co. (D. C.), 13 F. (2d) 241;

Carson v. Am. Smelting Co. (C. C. A.), 4 F. (2d) 463;

Murphy Wall Bed Co. v. Rip Van Winkle Wall Bed Co. (D. C.), 295 F. 748;

Globe Knitting Works v. Segal (C. C. A.), 248 F. 495;

Morton v. Llewellyn (C. C. A.), 164 F. 697.

That the machines manufactured by the appellee have achieved commercial success is established by the testimony of Mr. Archie Block, Vice-President of Dinuba Associates, Ltd., appellee herein, who testified as follows (R. 56):

“Dinuba Steel Products Corporation sold between 100 and 150 machines under the Petzoldt

patent, and has licensed another machinery manufacturing firm under the patent on a five per cent royalty of the selling value.”

“The imitation of a thing patented, by defendant, who denies invention, has often been regarded, perhaps, especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think.”

Judge Hough, in the case of *Kurtz v. Belle Hat Co.* (C. C. A.), 280 F. 277, 281. Also Judge Mayer, in the case of *General Electric Co. v. Mallory* (D. C.), 294 F. 562, 564. Also Judge Coxe in the case of *David v. Harris*, 206 F. 902, 903, 124 C. C. A. 477, 478:

“The fact that the defendant is making his sweaters under a subsequent patent to Rautenberg makes the defense of lack of novelty and invention come with rather poor grace from one who is asserting that even after the complainants’ patent there was still room for invention.”

PETZOLDT FILE WRAPPER.

The admissions made in the File Wrapper by the patentee are binding upon him and the appellee does not seek to change, modify, or alter any of said admissions. The appellee is not attempting to explain the meaning of the claim in suit beyond the ordinary interpretation of the words used in the claim to define the invention, nor is the appellee attempting to embrace within the claim any rights which the patentee

may have waived or which may have been denied to the patentee by the Commissioner of Patents.

At the beginning of the trial, appellee stated its position clearly and unequivocally. *It was admitted that the patent claim was narrow, and it was admitted that the claim should not be broadly interpreted.*

THE CLAIMS OF THE PATENT IN SUIT ARE NOT SO LIMITED BY THE FILE HISTORY OF THE PATENT APPLICATION AS TO EXCLUDE DEFENDANT'S MACHINE FROM INFRINGEMENT.

Another of the defenses urged by the defendant is that the claims of the patent in suit are restricted by the proceedings in the Patent Office during the prosecution of the application upon which the patent was granted which, it contends, act as an estoppel to an interpretation of the claims broad enough to permit them to be read upon the defendant's machine.

THE PATENT CONTRACT.

We submit the following as essential and well settled principles of the patent law relating to the interpretation of patents:

(1)

A patent is a contract and is to be construed as such; to cover, if possible, all the novelty and invention which is contained within its "four corners."

"In construing a patent, which is a technical document, it is a primary rule that a patent, like

any other written instrument, is to be interpreted by its own terms.”

Goodyear v. Davis, 102 U. S. 222; 26 Law Ed. 149.

“Liberal construction of a patent should be given in harmony with the intent and purpose of the law.”

Mossberg v. Nutter, 135 F. 95;

American Brake Shoe v. Hoadley, 222 F. 327;

McMichael v. Stafford, 105 F. 380;

Ryder v. Schlichter, 126 F. 487.

“In a suit for infringement of a patent if there be a way compatible with reason and common sense to avoid a construction which declares that a patent has no claim which will protect the invention, that way should be found and followed though the claims may be capable of another construction. When forced to choose between a construction which destroys and one that saves a patent, the court should not hesitate to adopt the latter.”

Gaisman v. Gallert, 105 F. 955;

Malignani v. Jasper, 180 F. 442 (C. C. A. (Mass.);

National v. Interchangeable, 106 F. 693 (45 C. C. A. 544);

Comptograph v. Universal, 142 F. 539;

Denning Wire Fence Co. v. American, 169 F. 793;

Morrison v. Sonn, 111 F. 172;

American v. Helmstatter, 129 F. 919;

Hildreth v. Mastoras, 253 F. 69, aff. 257 U. S. 27; 66 Law Ed. 112.

(2)

An inventor may claim the specific construction illustrated in his patent and also have a general broad claim and when this is done, in order to sustain the broader claim, it is not necessary that he should point out in his patent that the specific construction shown is not essential to the invention.

The case of *Ryder v. Townsend*, 188 F. 792, is a case in point. In that case the patentee in his first, second and third claims claimed specific devices in combination and in his fourth claim he claimed the combination in general, not limited to the specific thing pointed out in the specification. The Court says:

“This last claim, in question here, is not limited in terms to any specific form of brace, or door, or reinforce, and for the court to do so would be rewriting the claim and importing into it limitations not found in the claim itself *and certainly not imposed by any action of the Patent Office or by the prior art.*”

(3)

In construing a claim one must have in mind the nature of the patent, its character as a pioneer invention or otherwise and the state of the art at the time the invention was made.

Cimiotti v. American, 189 U. S. 406; 49 Law Ed. 1104;

Letson v. Alaska, 139 F. 129;

Roberts v. Bruckman, 266 F. 986;

Bruckman v. Denaro, 297 F. 913.

(4)

A claim of a patent which is met in terms only is not necessarily invalid.

“The principle of the invention will be taken into consideration.”

New England Motor v. Sturtevant, 140 F. 866.

(5)

A claim in a patent, when not ambiguous, is to be construed according to the meaning of its own terms in the light of the specification and drawings only and the file wrapper cannot be resorted to to vary the language of the claim.

“Undoubtedly, a patent, like any other written instrument, should be interpreted by its own terms.”

Goodyear v. Davis, 102 U. S. 222; 26 Law Ed. 149;

Fullerton v. Anderson-Barngrover, 166 F. 443.

The file wrapper of a patent may be resorted to to confirm a particular construction which the patent bears on its face.

“But when a patent bears on its face a particular construction inasmuch as the specification and claims are in the words of the patentee, it is reasonable to hold that such a construction may be confirmed by what the patentee said when he was making his application. The understanding of a party to a contract has always been regarded as of some importance in its interpretation.”

Goodyear v. Davis, 102 U. S. 222.

(6)

The File Wrapper of a patent may be examined to determine the question of estoppel through rejected claims and if a patentee acquiesces in the rejection of his claims on references cited in the Patent Office and accepts a patent on an amended claim or a substituted claim, he is thereby estopped from maintaining that the amended or substituted claim covers the devices or combinations shown in the references, and from successfully claiming that the amended or sub-

stituted claim has the breadth of the claims that were rejected. This, however, is the limit of the estoppel and the patentee is not estopped from claiming and securing by an amended or other claim, every improvement he has in fact invented that was not disclosed by the references on which his original claim was rejected.

“The court examines the file wrapper of a patent only to determine the question of estoppel through rejected claims.”

Spalding v. Wanamaker, 256 F. 530 (C. C. A., Second Cir.);

Batzley v. Spengler, 262 F. 423 (C. C. A., Second Cir.);

Boyer v. Keller, 127 F. 130 (Third Cir.);

McCormick v. Medusa, 222 F. 288 (C. C. A., Seventh Cir.).

“Arguments and explanations in support of an application for a patent, to make clear the true nature and merits of the invention, and amendments to emphasize them, are not to be construed as limitations on the claims of the patent as allowed.”

McCormick v. Medusa, 222 F. 288 (C. C. A., Seventh Cir.).

See also:

Daylight v. Marcus, 110 F. 980;

Dodge v. Jones, 153 F. 186;

Pangborn v. Sly, 284 F. 220;

Rembert v. American, 129 F. 355;

National v. Spang, 135 F. 351;

- Webber Electric v. Freeman*, 256 U. S. 668; 65
Law Ed. 1162;
Tomson-Houston v. Wagner, 119 F. 178;
U. S. Peg Wood v. Sturtevant, 122 F. 479;
Safety Oiler Co. v. Scovill, 110 F. 203;
General Fire Extinguisher Co. v. Mallers, 110
F. 529; 49 C. C. A. 139;
Piefer v. Brown, 112 F. 435; 50 C. C. A. 331;
U. S. Peg Wood v. Sturtevant, 125 F. 382; 60
C. C. A. 248;
Hess-Bright Mfg. Co. v. Fitchel, 219 F. 723;
*Veneer Machinery Co. v. Grand Rapids Chair
Co.*, 227 F. 419;
Stromberg v. Zenith and Zenith v. Stromberg,
254 F. 68, C. C. A., Seventh Cir.;
St. Louis v. American, 156 F. 574;
Haskell v. Perfect, 143 F. 128;
Seegar v. American, 171 F. 416;
Sharp and Smith v. Physicians, 174 F. 424;
Haywood v. Syracuse, 152 F. 458;
Valvona v. Marchiony & Valvona, 207 F. 380.

PATENTS ALLEGED TO ANTICIPATE.

The prior art patents relied upon by the appellant to anticipate the Petzoldt patent, are as follows:

- | | | | | |
|-------------------|---|-------------|---------------------|-----------|
| 1. Wilson patent, | # | 185,612, | Defendant's Exhibit | "B-13"; |
| 2. Beckwith | " | # 301,081, | " | " "B- 2"; |
| 3. Mader | " | #1,543,116, | " | " "B- 6"; |
| 4. Rupprecht | " | #1,361,906, | " | " "B- 7"; |
| 5. Hudson | " | #1,710,222, | " | " "B- 4". |

Wilson patent.

The Wilson patent is an ordinary form of horse drawn hay rake, utilizing a ratchet wheel E, in combination with a system of pawls N, for lifting the hay rake G, upwardly at intermittent intervals. The claim of the Petzoldt patent in suit is not to be found element for element in the Wilson patent, operating in the same manner to produce the same result. The primary object of the Petzoldt patent is to lift the frame with the plowing tool on it, out of the ground. In the Wilson patent the frame C is fixed to a cross axle, and the frame is never moved, either upwardly or downwardly, by the action of the pawls engaging the ratchet wheel. But even if, in the Petzoldt device, the plowing tool were swung up out of the ground, independently of any movement of the frame, a device would not be formed comparable to the disclosure of Wilson. It is one matter to swing the light tines of the rake of the Wilson patent, and another thing to elevate the plowing tool of the Petzoldt patent. The resistance created by drawing the plowing tool through the soil in the Petzoldt device, is transmitted directly from the plowing tool to the frame on which the tool is mounted, and thence to the tractor pulling said implement. When the plowing tool is elevated out of the ground, the pulling force of the tractor is still transmitted to the frame. The Petzoldt patent requires that the frame of the implement and the plowing tool be a rigidly connected unit, and that every lifting movement of the plowing tool be accomplished through a power lift interposed between the frame and the tractor wheels. It is an entirely unjustifiable

assumption that the Petzoldt plowing implement could be substituted in the Wilson structure in place of the hay rake.

Appellant admits that the Killefer structure follows the teachings of the Hudson patent No. 1,710,222, which was granted on April 23, 1929, and by a process of reasoning unknown to the appellee, assumes that the Killefer structure is not anticipated by the Wilson patent, although appellant argues the Wilson patent should anticipate the structure claimed by the appellee in the Petzoldt patent.

The testimony of defendant's expert witness, Doble, on this point is very enlightening.

"The tools manufactured by Killefer Company which embody the features of the Hudson patent are the Killefer subsoil plows, Killefer chisels and rippers.

The structure as disclosed in the Wilson patent is closer to the structure of the Petzoldt patent than to the Killefer type of structure. *The Killefer structure is closer to the Petzoldt than it is to the Wilson patent.*" (Italics ours.) (R. 169-170.)

It is important to note that in the opinion of defendant's expert, Doble, the Killefer structure is closer to Petzoldt than it is to the Wilson patent. On cross-examination, the expert Doble, testified that in the Wilson patent he did not find any of the essential parts specified in the claim of the Petzoldt patent:

1. No axle journaled transversely of the frame;

2. No arm on each axle terminating at the lower end with a spindle;
3. No traction wheels rotatable on the spindle;
4. No pair of discs mounted on one spindle and fixed to the adjacent wheel;
5. No ratchet wheel in the Wilson patent like in Petzoldt;
6. No pins in the ratchet wheel;

and the expert, Doble, succinctly defines the pertinency of the Wilson patent to the Petzoldt structure by the following statement:

“All of the elements of the Petzoldt claims are not found in the Wilson patent, not in their specific forms, but in a general combination.” (R. 171.)

Beckwith patent.

The Beckwith patent discloses a wheeled road scraper and illustrates a device which has absolutely no similarity either in appearance, or in operation, or in structure, to the tool described in the Petzoldt patent. The one thing which the Beckwith patent does show, is a pair of discs on each tractor wheel connected by circumferentially spaced pins. Other than this one point in common, there is no similarity or likeness between the Petzoldt and Beckwith structures. In the Beckwith patent, the object of the invention is to accumulate a scraper full of dirt and then by means of the ratchet lifting mechanism on the wheels, to elevate the scraper into a position where the contents of the scraper will be dumped out.

It is interesting to note how the defendant's expert, Doble, contrasted the tool made by the Killefer Company with the tool shown in Petzoldt's patent, and the tool shown in the Beckwith patent:

"Mr. Doble, I will call your attention to this Beckwith patent, Defendant's Exhibit 'B-2,' and I want to know whether the type of power lift used by the Killefer Company and the complete structure, plow structure or structure manufactured by the Killefer Company, bear a closer resemblance to the form of device shown in the Beckwith patent or to the form of device shown in the Petzoldt patent? * * *

A. It more closely resembles the Petzoldt patent, but still it is of a different type than either of the other two." (R. 177-178.)

On cross-examination, defendant's expert, Doble, also testified that the scraper box E of the Beckwith patent was, in his opinion, the equivalent of the frame of the Petzoldt patent, and that it is the "body" of the machine. (R. 179.) Now, the Petzoldt patent definitely shows a "body" on which a plowing tool is mounted, and it would be possible to remove the plowing tool from the "body" without in anywise affecting the action of the power lift in elevating the "body" relative to the ground. If the scraper box E of the Beckwith patent is the "body" of that machine, as the expert Doble says it is, then if said scraper box were removed from the implement, it would not be an operative machine at all. The racks in the Beckwith patent assume positions entirely different in operation from those of the pawls in the Petzoldt patent,

and the racks in the Beckwith patent cause the scraper box to go through certain convolutions which it would be impossible to achieve with the pawls of the Petzoldt patent.

The defendant's expert, Doble, contends that the Beckwith patent shows a structure which is the same as the Petzoldt tool, and yet the following testimony of the expert states many reasons why the tools shown by the Beckwith and Petzoldt patents are entirely different.

“The frame in the Petzoldt patent never assumes the inverted position shown by the scraper pictured in the Beckwith patent because the Beckwith patent is a power lift applied to a different type of implement. It would not be possible or desirable in the Petzoldt patent to raise the frame to the inverted position shown by the Beckwith patent, *and it would not be mechanically possible to do it without changing the frame.* You could not do it in the construction of the Petzoldt device as shown in the Patent, which is merely the application of a power lift to a different form of earth-working tool, such as called for in the Petzoldt patent.”
(Italics ours.) (R. 180.)

Mader patent.

The Mader patent discloses a power lift on an agricultural implement. The elements set forth in the claim of the patent in suit cannot be found in the Mader patent. The arrangement of the axle specified in the Petzoldt claim is essentially different from the axle arrangement shown in the Mader patent. The

pawls of the Petzoldt patent are mounted on a shaft in a predetermined location relative to the axle, and neither the pawls nor the arrangement thereof is to be found in the Mader patent. The type of pawl claimed in the Petzoldt patent is entirely different from the toothed rack or lifting arm 40 shown in the Mader patent.

It is important to note that the Mader application and the Petzoldt application were copending in the Patent Office at the same time. The Petzoldt patent having been filed in the Patent Office about six months after the Mader application, and the Petzoldt patent issued about ten months after the Mader patent. For a period of about two years and three months, the Mader and Petzoldt applications were copending, and yet there was no interference declared between the respective applications. If Mader had attempted to claim that which Petzoldt was seeking to claim, or vice versa, there would have been an immediate conflict between the respective applications and the Patent Office would have determined who was the inventor of the matter in dispute. The appellee is not attempting to assert that the claim of the Petzoldt patent is of such scope as to dominate a structure made in accordance with the Mader patent. The Mader patent preceded the Petzoldt patent, and Mader is at perfect liberty to make and sell his structure without any interference from the Petzoldt patent.

The Mader patent has no transverse axle with arms at each end thereof terminating at the lower end

with a spindle, and with a traction wheel rotatable on each spindle, as called for by the Petzoldt claim. Furthermore, the Mader patent does not have any elongated pawl pivotally mounted on the frame underneath the axis of the axle. Instead the Mader patent has a toothed rack attached to the frame above the level thereof. Killefer has adopted the axle construction of Petzoldt and not the axle construction of Mader. Killefer has also adopted the pawl structure of Petzoldt, and not the rack structure of Mader. The pawl of Petzoldt could not be placed on the Mader tool in lieu of the rack shown therein, to form an operative structure. Killefer has borrowed nothing from the Mader patent but has bodily appropriated the Petzoldt structure.

Rupprecht patent.

The Rupprecht patent No. 1,361,906 discloses a cultivator having a power lift device thereon. The construction of the Rupprecht tool, and particularly the power lift mechanism, is specifically different from the power lift mechanism set forth in the claim of Petzoldt. Once again the appellee is not attempting to assert that the claim of the Petzoldt patent covers such a structure as that shown by Rupprecht, nor does the Rupprecht patent anticipate the structure which the appellee has embodied in his claim. The Rupprecht patent discloses a rack form of a lift bar 32 which is entirely different from the pawl type of mechanism specified in the Petzoldt patent. The Rupprecht and Mader patents cover very similar

power lift mechanisms, both being of a different type from the one claimed in the Petzoldt patent. The structure specified in appellee's claim, is not to be found, element for element, in the Rupprecht patent, and hence the mode of operation of the device shown by Rupprecht is different from that specified in the Petzoldt patent.

It is true that the Rupprecht patent and the Mader patent describe how to accomplish the raising of a plowing implement out of the ground through rack bars on the frame cooperating with ratchets on the tractor wheels of the vehicle, but the means specified are not the same as those specified by Pezoldt in the claim of the patent in suit.

Neither the Rupprecht nor the Mader patents were cited against the Petzoldt application during its prosecution through the Patent Office. It is to be assumed that the Patent Office knew of these patents, and if they had been considered pertinent to the structure claimed by Petzoldt, they would have been cited as anticipatory thereof.

Killefer has borrowed nothing from the Rupprecht patent but has borrowed the gist of the Petzoldt invention, otherwise the appellant would not have attempted to excuse and apologize for the action of the Patent Office (page 39, Appellant's Brief), where no excuse or apology was necessary.

The District Court was correct in its judgment of the prior patents introduced in evidence, in stating

that none of them performed the same function in the same way as the Petzoldt device. (R. 45.)

“Prior structures, which by modification might be made to perform functions of one later patented, are not anticipations, where not designed, adapted to, nor used for such functions,

Tashjian v. Forderer Cornice Works, 14

Fed. (2d) 414;

Topliff v. Topliff, 145 U. S. 156;

Los Alamitos v. Carroll, 173 Fed. 280.”

Appellant's theory of the Petzoldt patent as it might be affected by the prior patents in the analogous art, is that it could not possibly be valid, because it is a combination of elements, every one of which is ancient and notoriously old. To advance appellant's theory further would be tantamount to holding that no new patents should be issued. The appellant knows that the appellee is not attempting to assert that the claim of the Petzoldt patent covers all types of power lift implements which preceded it. The Petzoldt patent has claims which are narrow and specific. The Petzoldt patent has carved out a very small niche in the art of which it is a part, and the Killefer structures are not entitled to occupy Petzoldt's niche without paying tribute therefor.

The form of power lift mechanism device shown by Petzoldt is not shown or described in the Beckwith, Wilson, Mader or Rupprecht patents. Those patents do show power lift mechanisms for elevating an earth working tool out of the ground. Petzoldt

has claimed his particular form of power lift mechanism in definite and specific terms and the power lift described by Petzoldt is not to be found in any of the prior patents relied upon by the appellant. The appellee concedes that there are many power lift devices patented previous to Petzoldt, all of which will accomplish the raising of an earth working tool from the ground, but maintains that none of these prior patents show the same elements, or follows the same mode of operation as that specified by Petzoldt. The appellee does not claim to have any patent on a mode of operation covering the lifting apparatus. Appellee maintains that the Petzoldt patent describes a peculiar combination of elements, put together in a certain way to function in a particular manner, and that the same combination of elements, operating in the same way to produce the same result, is not found in the prior patents, but is found in the Killefer structure.

Hudson patent.

The Hudson patent No. 1,710,222, is relied upon by the appellant with great stress. The Hudson patent was filed in the Patent Office about nine months after the filing of the Petzoldt patent, and the Hudson patent did not issue until approximately three years after the issuance of the Petzoldt patent. Both of these applications were copending for about two years and four months, and yet there was no interference declared between the two applications. The Petzoldt patent being earlier than the Hudson

patent, anticipates it. This rule is clearly established by the Supreme Court of the United States in

Milburn Co. v. David-Bournonville Co., 70 Law Ed. 651,

the decision in which is summarized in the head note as follows:

“A description in an application for a patent of a thing claimed in a subsequent application by another, filed before the patent is issued, is a disclosure which, in the absence of evidence carrying the invention of the second claimant further back, prevents issuance of patent to the second claimant, although it was not claimed in the first application.”

As between copending applications, respective filing dates fix respective dates of invention in absence of other evidence. (*Fleischmann Yeast Co. v. Federal Yeast Corporation*, 8 F. (2d) 186, 201.) The grant of a later patent is evidence only that a patentable difference exists between the device shown and that of a prior patent, and not that it does not infringe the earlier patent. (*Herman v. Youngstown Mfg. Co.*, 191 Fed. 579.)

The Court below apparently drew the inference from the testimony of appellant's expert Doble, that the Killefer tools bore a closer resemblance to the Petzoldt patent than to any other patent of record.

“Mr. Doble, I will call your attention to this Beckwith patent, Defendant's Exhibit 'B-2,' and I want to know whether the type of power lift used by the Killefer Company and the complete structure, plow structure or structure manu-

factured by the Killefer Company, bear a closer resemblance to the form of device shown in the Beckwith patent or to the form of device shown in the Petzoldt patent?

The Court. You have already gone over that.

Mr. Johnson. That was with another patent.

The Court. Didn't you ask him the general question whether or not the implement made by the Killefer Company did not more closely resemble the Petzoldt patent than any other?

Mr. Johnson. I probably did. I did not understand that the question would have that scope in your Honor's mind.

The Court. Let me have the patents, Mr. Clerk.

A. *It more closely resembles the Petzoldt patent, but still it is of a different type than either of the other two.*" (Italics ours.) (R. 177-178.)

Appellee's expert Baldwin Vale, testified that none of the prior art patents anticipated, nor disclosed structures similar to the Petzoldt device, as follows:

"I have examined all of the prior art patents that the defendant has set up in its answer, and also those which they have relied upon and have introduced here in evidence. I will say that the Killefer structure bears a closer resemblance to the Petzoldt patent than to any other patent to be found in the prior art that has been introduced here in evidence. In my opinion the power lifting apparatus embodied in the Killefer tools involves all of the elements set forth in claim 1 of the Petzoldt patent, and *it is of course obvious in an art as closely crowded as this has obviously been since the seventies, that there are going to*

be individual elements borrowed from the prior art in any construction that would be built along these lines, but apparently Killefer has followed the teachings of Petzoldt.

There is no patent in the prior art which I have examined which, so to speak, is a Chinese copy of the Killefer construction as it is manufactured at present, but I would say that the Killefer construction is a Chinese copy of the construction shown in the Petzoldt patent. I find every element of claim 1 of the Petzoldt patent in the Killefer construction.” (Italics ours.) (R. 201.)

Whether or not the device patented by Petzoldt arises to the dignity of invention, is a point which the Patent Office has already passed upon in the grant of the patent to Petzoldt, and the Petzoldt patent no more covers “trivial” matter than does the Hudson patent or any of the other patents owned by the appellant.

The Killefer Company also owns such patents as the Thayer patent No. 1,505,679; Towner patent No. 1,452,855; and Watters patent No. 1,487,413, all of which were patented ahead of the Petzoldt patent, and all of which patents cover power lifts for ground working implements. All of these patents disclose structures which the Killefer Company could utilize to avoid infringement of the Petzoldt patent.

Undoubtedly the Killefer Company has seen fit not to adopt the power lifts disclosed by the patents which it owns for the reason that the Petzoldt structure is much simpler to operate, cheaper to manu-

facture, and more efficient in operation. The Killefer Company had the entire patent art on power lift implements at its command when it sought to adopt a power lift structure, and there is no just reason why they should be allowed to boldly copy that of Petzoldt.

In the case of *Bankers' Utilities Co. v. Pacific Nat. Bank*, 32 F. (2d) 105, this Court has said:

“In section 359 of Walker on Patents (5th Ed.), the learned author says: ‘Primary inventions are entitled to a somewhat looser application of this definition of an equivalent than those inventions which are secondary. But a patentee is not to be denied the benefit of the doctrine of equivalents to the extent necessary to protect his actual invention, although the invention may be a narrow one. A fair statement of the rule is that “the range of equivalents covered by the patent corresponds with the character of the invention, and includes all forms which embody the substance of the invention, and by like mechanical cooperation effect substantially the same result.” ’ ’ ’

And in *Butler v. Burch Plow Co.*, 23 F. (2d) 15, we said:

“Unquestionably there is some difference in the structure of the machines, but we think there is no difference in principle. We look more to the substance of things than their forms.

‘Where a combination patent marks a distinct advance in the art to which it relates, as does the appellant’s invention here, the term “mechanical equivalent” should have a reasonably

broad and generous interpretation, and protection against the use of mechanical equivalents in a combination patent is governed by the same rules as patents for other inventions.

Imhaeuser v. Buerk, 101 U. S. 647, 25 L. Ed. 945' * * *

Defendants therefore cannot escape infringement by adding to or taking from the patented device by changing its form or even by making it somewhat more or less efficient, while they retain its principle and mode of operation and attain its results by the use of the same or equivalent mechanical means.

Louire v. Lenhart, 130 F. 122, 64 C. C. A. 456."

Whether by the slight changes defendant's device is rendered less attractive or more attractive to the public we need not determine. It is sufficient to say that it embodies plaintiff's invention.

This Court also held to a similar view in the case of *Butler v. Burch Plow Co.*, 23 F. (2d) 15.

"Appellants insist that the three patents in suit are invalid, in view of the prior art. The Circuit Court of Appeals for the Second Circuit has said that the principal question in cases of this character is:

'Has the patentee added anything of value to the sum of human knowledge? Has he made the world's work easier, cheaper and safer? Would the return to the prior art be retrogression? When the court has answered this question, or these questions, in the affirmative, the effort

should be to give the inventor the just reward of the contribution he has made.

The effort should increase in proportion as the contribution is valuable. When the court has to deal with a device which has achieved undisputed success and accomplishes a result never attained before, which is new, useful, and in large demand, it is generally safe to conclude that the man who made it is an inventor. The court may resort to strict, and it may even be to harsh, construction, when the patentee has done nothing more than make a trivial improvement upon a well-known structure which produces no new result; but it should be correspondingly liberal when convinced that the patentee's improvement is so radical as to put the old methods out of action. The courts have frequently held that one who takes an old machine, and by a few even inconsequential changes compels it to perform a new function, and do important work which no one before ever dreamed it capable of performing, is entitled to rank as an inventor.'

O'Rourke Engineering Const. Co. v. Mullen (C. C. A.), 160 F. 933, 938.

'The keynote of all the decisions is the extent of the benefit conferred upon mankind. Where the court has determined that this benefit is valuable and extensive, it will, we think, be difficult to find a well-considered case where the patent has been overthrown on the ground of nonpatentability.'

O'Rourke Engineering Const. Co. v. Mullen, *supra*.

In the same case the court quotes from

Hobbs v. Beach, 180 U. S. 383, 392, 21 S.

Ct. 409, 413 (45 L. Ed. 586) as follows:

‘* * * While none of the elements of the Beach patent,—taken separately, or perhaps even in a somewhat similar combination—was new, their adaption to this new use and the minor changes required for that purpose resulted in the establishment of practically a new industry, and was a decided step in advance of any that had theretofore been made.

‘In administering the patent law, the court first looks into the art to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent to secure to the inventor the reward he deserves. If what he has done works only a slight step forward, and that which he says is a discovery is on the border line between mere mechanical change and real invention, then his patent, if sustained, will be given a narrow scope, and infringement will be found only in approximate copies of the new device. It is this differing attitude of the courts toward genuine discoveries and slight improvements that reconciles the sometimes apparently conflicting instances of construing specifications and the finding of equivalents in alleged infringements. In the case before us, for the reasons we have already reviewed, we think that Eibel made a very useful discovery, which has substantially advanced the art. His was not a pioneer patent, creating a new art; but a patent which is only an improve-

ment of an old machine may be very meritorious and entitled to liberal treatment.'

Eibel Co. v. Paper Co., 261 U. S. 45, 63, 43 S. Ct. 322, 328 (67 L. Ed. 523).

'The defendant claimed that the complainant's device was anticipated by the prior art. To authorize the allowance of a patent, there must be a substantial difference in principle from prior inventions. To amount to anticipation it is essential that there should be identity in substance, and the two things must accomplish the same purpose by substantially the same means, operating in substantially the same way. And a patentee's claim to an invention is anticipated when it appears that another made the invention before the date when the patentee made it. The anticipation may consist of prior patents or publications. And if prior invention is shown to have existed and been in use, it is clearly of no consequence whether it was patented or not. In the case at bar our attention has been called to a number of prior patents which defendant alleges show that the complainant's device was anticipated. But an examination of the patents referred to convinces us that there is absolutely nothing in the claim of anticipation by the prior art. The prior patents do not disclose or in any way suggest the invention of the patent in suit.'

Boyce v. Stewart-Warner Speedometer Corporation (C. C. A.), 220 F. 118, 124.'

CONCLUSION.

Appellee therefore contends plaintiff's patent in suit has been infringed by the devices made by the defendant; that the claim of the patent in suit reads perfectly upon defendant's structure; that the tools manufactured by defendant have all of the necessary elements, and operate and function in a fashion exactly in accordance with the claim of plaintiff's patent; and that the attempt on the part of defendant to show that by the prior art, plaintiff's patent was anticipated, has failed.

Dated, San Francisco,
January 20, 1933.

Respectfully submitted,

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